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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,794

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Federico Mailland

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04/21/2008

NIXON & VANDERHYE, PC

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

04/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,794

**Applicant(s)**

MAILLAND, FEDERICO

**Examiner**

Christopher R. Tate

**Art Unit**

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-29 and 48-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-29 and 48-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 22 January 2008 is acknowledged and has been entered. Claims 25-29 and 48-79 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

Claims 25-29 and 48-79 are/stand rejected under 35 U.S.C. 103(a) as being unpatentable over the PDR for Herbal Medicines (1998) and Koniger et al. (WO 94/25041 - Derwent Abstract plus Machine Translation thereof), in view of Ramin (JP -285830 - which corresponds to US 5,667,768) and Trimuyadi et al. (Conference of the Asian Societies, 2001) for the reasons set forth in the previous Office action.

Applicant's arguments regarding the USC 103 rejection above (including the furnished Enclosure I and 2 publications referred to therein) have been carefully considered but are not deemed to be persuasive of error in the rejection. Applicant argues that onychoschizia is not a generic condition of nail brittleness, but rather a specific and well characterized pathology of the nails (as discussed within Applicant's Enclosure 1 publication), and that the cited references contain no disclosure or suggestion of this pathology, and none of them would lead one of ordinary skill to believe that *Equisetum* could be beneficial in the treatment of onychoschizia.

However, as readily admitted by Applicant, this type of nail splitting - i.e., onychoschizia (as well as unguis brittleness) is a widespread condition that affects mainly housewives - including 25-37% of normal adult women, as well as workmen and workwomen, dressmakers, nurses, and other employees. (see, e.g., page 2, line 11 - page 3, line 1, of the instant specification).

Applicant further argues that onychomycosis (nail fungal infection) and onychoschizia are different and unrelated conditions that require two completely different treatments (as discussed within Applicant's Enclosure 2 publication). However, please note that "onychomycosis" is medically defined as "fungal infection of the nail plate... producing nails that are opaque, white, thickened, friable, and brittle" (Dorland's Illustrated Medical Dictionary, 27th ed., 1988). As set forth in the previous Office action, the PDR for Herbal Medicines expressly and beneficially teaches the well-known folk-medicine usage of *Equisetum arvense* (horsetail) "for treating brittle finger nails" - as well how to prepare external/topical preparations thereof (including in the form of extracts); and Koniger et al. beneficially teach the topical use of *Equisetum* (*Equisetum arvense* - misspelled as *arvernse* in this document, and/or *Equisetum hiemale*) extracts to treat fungal infections of the fingernails. Accordingly, the topical use of *Equisetum* (including in the form of an extract thereof) for treating brittle nails (whatever the underlying pathology) - including brittle nails widespread and commonly caused by onychoschizia or brittle nails resulting from and/or commonly associated with onychomycosis, would clearly have been obvious based upon the beneficial teachings provided by the primary references cited above, for the reasons set forth in the previous Office action.

Applicant did not argue the teachings of the secondary references cited above within the 22 January 2008 response. However, as discussed in the previous Office action, the adjustment of particular conventional working conditions (e.g., selecting various conventionally employed active ingredients and carriers, and/or determining suitable ratios/amounts thereof, such as defined by the amended claims as well as new claims 48-79, therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan having the overall cited references (including the teachings provided by the secondary references cited above) before him/her as a guide.

Further, with respect to the two primary references (i.e., PDR and Koniger et al.), Applicant has argued and discussed references individually without clearly addressing the combined teachings. It must be remembered that the cited references (including the primary and secondary references) are relied upon in combination and are not meant to be considered separately as in a vacuum. It is the combination of all of the cited and relied upon references which make up the state of the art with regard to the claimed invention. Applicant's claimed invention fails to patentably distinguish over the state of the art represented by the references.

In addition, please note the Supreme Court has recently acknowledged that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. **If a person of ordinary skill can implement a predictable variation..103 likely bars its patentability...**...if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions...

**...the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results** (see *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 U.S. 2007) emphasis added.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Conclusion**

No claim is allowed.

Regarding Applicant's statement under the heading Priority Claim on pages 13-14 of the 22 January 2008 response, please note that box 12(c)(3) was incorrectly checked on the cover of the previous Office action. The cover of this Office action correctly states that, to date, no priority document has been received (i.e., the Examiner could not find a copy of the priority EPO document cited in Applicant's Oath within the incoming electronically-scanned documents for this Application) - accordingly, box 12(c)(1) has been checked.

The examiner assigned to this Application has changed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655